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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,166	02/17/2004	Dwight L. Pierce	62764-00010USPT	1287

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Jenkins & Gilchrist, a Professional Corporation
1401 McKinney
Suite 2700
Houston, TX 77010

EXAMINER

MOLINA, ANITA C

ART UNIT	PAPER NUMBER
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3626

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/780,166

Applicant(s)

PIERCE, DWIGHT L.

Examiner

ANITA MOLINA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 05/18/2004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims 16-20 can be reasonably interpreted as encompassing a human being, which is non-statutory subject matter (see: MPEP 2105).

1. Claims 1-8 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

2. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

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3. Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Furthermore, the method steps fail to transform underlying subject matter to a different state or thing. The mere storing, receiving and accessing data is not a transformation because a data is not statutory subject matter. Thus, claims 1-8 are non-statutory since they are not tied to another statutory class and they do not transform underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 3-5, 7, and 9-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0019794 to Moradi et al, hereinafter, Moradi in view of US in view of US 6,263,330 to Bessette.

As per claim 1, Moradi teaches a method of facilitating patient access to pharmacies, comprising:

-establishing a prescription registry in which patients who have joined said prescription registry may store information regarding their prescriptions (see: paragraph 35);

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-receiving and storing said information in said prescription registry (see: paragraph 36);

-providing said patients with a list of pharmacies that have subscribed to said prescription registry, said list including contact information which said patients may use to contact and provide said pharmacies with one or more prescription identifiers (see: paragraph 40); and

Moradi fails to teach **assigning a unique prescription identifier to said information for each prescription, said unique prescription identifier initially known only to said patients and said prescription registry; and allowing said pharmacies to access said information stored on said prescription registry using said prescription identifiers.** Bessette teaches assigning a unique identifier (URL) to patient medical data (see: column 3, lines 57-66). Bessette also teaches allowing access to specific medical data using the unique identifiers (URLs) depending on the level of access granted by the patient (see: column 10, lines 6-22). It would have been obvious to one of ordinary skill in the art to include in the prescription delivery system of Moradi, the unique identifiers as taught by Bessette because the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per claim 3, Moradi teaches the claimed method, **wherein said step of receiving said information includes receiving a scanned image file of an original prescription slip for each prescription (see: paragraph 36).**

As per claim 4, Moradi teaches the claimed method, wherein said step of receiving said information further includes obtaining physical possession of an original prescription slip for each prescription (see: paragraph 36). It is noted that one would have to physically possess a prescription slip in order to scan it.

As per claim 5, Moradi teaches the claimed method, wherein said prescription identifier includes a fill code for each patient that may be used for all prescriptions belonging to said patient (see: paragraph 95).

As per claim 7, Moradi teaches the claimed method, further comprising requiring said pharmacies to satisfy one or more qualification criteria, including passing a background check, in order to subscribe to said prescription registry (see: paragraph 166).

As per claim 9, Moradi teaches a system for facilitating patient access to pharmacies, comprising:

- a prescription registry, said prescription registry including at least one database therein for storing prescription information (see: paragraph 22) and further including a user interface for said at least one database (see: paragraph 194), said user interface comprising:

- a member login screen for allowing a member of said prescription registry to access said at least one database (see: paragraph 103);

- a prescription information screen for allowing a member services provider operator to capture prescription information for one or more prescriptions of said member (see: paragraph 52);

-a prescription upload screen for allowing said member services provider operator to upload said prescription information, including a scanned image file of each prescription, to said at least one database (see: paragraph 24); and

-a prescription acceptance screen for allowing said pharmacy to accept said one or more prescriptions and for locking each prescription that is accepted by said pharmacy from further access (see: paragraph 100).

Moradi fails to teach a **prescription verification screen for allowing a pharmacy to access said prescriptions using a unique prescription identifier, said prescription identifier initially known only to said member and said prescription registry**. Bessette teaches allowing access to specific medical data using unique identifiers (URLs) depending on the level of access granted by the patient (see: column 10, lines 6-22). It would have been obvious to one of ordinary skill in the art to include in the prescription delivery system of Moradi, the unique identifiers as taught by Bessette for the same reasons set forth for claim 1.

As per claim 10, Moradi teaches the claimed system, **wherein said user interface further comprises a membership application screen for accepting new members to said prescription registry (see: paragraph 137).**

As per claim 11, Moradi teaches the claimed system, **wherein said user interface further comprises a member services screen for allowing said member to search for member services providers and pharmacies (see: paragraph 40 and 171).**

As per claim 12, Moradi teaches the claimed system, wherein said user interface further comprises a member services screen for allowing said member to search for member services providers and pharmacies (see: paragraphs 40 and 171).

As per claim 13, Moradi teaches the claimed system, wherein said user interface further comprises a member services screen for allowing said member to update membership information (see: paragraph 148).

As per claim 14, Moradi teaches the claimed system, wherein said user interface further comprises a membership verification screen for allowing said member services provider operator to verify a membership of said member (see: paragraph 104).

As per claim 15, the system according to claim 9, wherein said user interface further comprises a membership verification screen for allowing said pharmacy to verify a membership of said member (see: paragraph 196).

As per claim 16, Moradi teaches a prescription registry service, comprising:
-a database configured to store prescription information (see: paragraph 22);

-members who upload their prescription information to said database (see: paragraph 36); and

-member services providers that assist said members to upload their prescription information to said database (see: paragraph 36).

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Moradi fails to teach **pharmacies that access said prescription information stored on said database, wherein said pharmacies are only allowed to access prescriptions for which they have been authorized by said members.** Bessette teaches allowing access to specific medical data using unique identifiers (URLs) depending on the level of access granted by the patient (see: column 10, lines 6-22). It would have been obvious to one of ordinary skill in the art to include in the prescription delivery system of Moradi, the access authorization as taught by Bessette for the same reasons set forth for claim 1.

As per claim 17, Moradi teaches the claimed prescription registry service, **wherein said members must surrender their original prescription slips to the prescription registry service before their prescription information are made accessible to said pharmacies** (see: paragraph 33).

As per claim 18, Moradi teaches the claimed prescription registry service, **wherein said database is configured to lock from further access any prescription information that have been accepted for filling by said pharmacies** (see: paragraph 100).

3. Claims 2, 8, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0019794 to Moradi in view of US 6,263,330 to Bessette and in view of US 2004/0006490 to Gingrich et al, hereinafter, Gingrich.

As per claim 2, Moradi fails to specifically teach the claimed method, **wherein all communications and transaction between said patients and said pharmacies take**

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place through said pharmacies' normal channels and not through said prescription registry. Gingrich teaches communication through traditional means with a pharmacy (see: paragraph 104). It would have been obvious to one of ordinary skill in the art to include in the prescription delivery system of Moradi, the traditional communication method as taught by Gingrich because the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per claim 8, Moradi fails to specifically teach the claimed method, **further comprising requiring said subscribing pharmacies to pay a fee to said prescription registry.** Gingrich teaches charging a fee for access to a prescription data exchange system (see: paragraph 33). It would have been obvious to one of ordinary skill in the art to include in the prescription delivery system of Moradi, the fee as taught by Gingrich for the same reasons set forth for claim 2.

As per claim 20, it is rejected for the same reasons set forth for claim 8.

4. Claims 6 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0019794 to Moradi in view of US 6,263,330 to Bessette and in view of US 6,973,435 to Sioufi et al, hereinafter, Sioufi.

As per claim 6, Moradi fails to teach the claimed method, **wherein said prescription identifier further includes a prescription number for each prescription of said patient.** Sioufi teaches a prescription number to identify an

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individual prescription (see: column 8, lines 6-10). It would have been obvious to one of ordinary skill in the art to include in the prescription delivery system of Moradi, the prescription number as taught by Sioufi because the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per claim 19, it is rejected for the same reasons set forth for claim 6. Also, see arguments for claims 1 and 5.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANITA MOLINA whose telephone number is (571)270-3614. The examiner can normally be reached on Monday through Friday 8am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ANITA MOLINA/
Examiner, Art Unit 3626
08/15/2008

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626